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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,780	11/10/2003	Satoshi Mizutani	20050/0200474-US0	4388
7278	7590	10/18/2006	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			STEPHENS, JACQUELINE F	
			ART UNIT	PAPER NUMBER

3761

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/705,780

Applicant(s)

MIZUTANI ET AL.

Examiner

Jacqueline F. Stephens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/24/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8 and 10-16 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 7/24/06 have been fully considered but they are not persuasive. Applicant argues McFall does not disclose the absorbent body is enclosed in a water permeable surface side sheet and water permeable or water impermeable backsheet. Applicant is directed to Figure 2 of McFall having water permeable sheets 34 and 38 enclosing the absorbent body. Applicant further argues the outer lobes 36, 38 of McFall are projecting vertically toward the body side of a wearer. The examiner interprets Figure 2 of McFall as showing the lobes projecting downward towards a garment side of the article.

Applicant argues Johnson does not provide the claimed shape. However, Johnson provides an absorbent body as claimed folded in a mountain fold and enclosed in a protruding area. Therefore, as broadly as claimed Figure 2 of Johnson shows first absorbent body forming the protruded area 3 and second absorbent body forming the flat area 10. The claimed formulas provide an obvious variant on the shape and is within the level of one of ordinary skill in the art.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson USPN 4595392.

As to claims 1, 2, and 11, Johnson discloses an interlabial pad having a water-permeable surface side sheet 7, an absorbent body 6, and a back side sheet 8. The interlabial pad comprises a flat area 10, a protruded area 3 in which a finger can be inserted for use (Figure 3). . However, the claim does not require the absorbent bodies are separate. Therefore, as broadly as claimed Figure 2 of Johnson shows first absorbent body forming the protruded area 3 and second absorbent body forming the flat area 10.

Johnson does not specifically disclose the dimensions of the article. However, In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

As to claim 3, see Figure 2

As to claim 4, see Figures 2 and 3.

As to claims 10, 12, and 13, the claims are directed to an intended use of the article. The manner in which the article is used is directed to an intended use of the article. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

3. Claims 1, 2, and 6-11 are rejected under 35 U.S.C. 102(e) as being anticipated by McFall USPN 6183587.

As to claims 1 and 2, McFall discloses an interlabial pad having a water-permeable surface side sheet 44, an absorbent body 22, and a back side sheet 72 (Figures 2-6). The interlabial pad comprises a second absorbent body flat area 24 and a first absorbent body protruded area 20. Figure 2 of McFall shows the absorbent 22 folded in a mountain fold and enclosed in the protruding area providing a hollow part, between F2 and F3 on the garment side of the protruding area. McFall does not specifically disclose the dimensions of the article. However, In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform

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differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

As to claim 6, the pad comprises a second protruded area 20A. The second protruding area has a second flat area (Figure 2)

As to claim 7, the pad has third absorbent body in the second protruded area (Figure 2).

Applicant admits the cylindrical portion of the present invention may be formed only when a finger is inserted therein (specification page 4, second paragraph). Therefore, the manner in which the cylindrical portion is formed is directed to an intended use of the article. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As to claim 8, McFall teaches orienting the absorbent material in the transverse direction to promote wicking in that direction (col. 19, lines 6-15).

As to claims 10 and 11, the claims are directed to an intended use of the article. see the discussion of claim 1 with regard to intended use limitations.

4. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson USPN4595392 in view of Farris et al. USPN 6131736.

Johnson does not disclose a wrapping sheet for covering and enclosing the interlabial product. Farris et al. discloses a packaging device including a wrapping

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sheet 40 for the benefit of storing the interlabial device until ready for use in such a manner that the user neither touches nor contaminates the surface of the absorbent in handling (Farris col. 5, lines 45-52). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Johnson to include a packaging device for the benefits taught in Farris.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jacqueline F Stephens
Primary Examiner
Art Unit 3761

October 16, 2006